

PATENT**Application # 10/042,143****Attorney Docket # 2000-0672A (1014-200)****REMARKS**

The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 2, 13, 24, and 35 has been cancelled without prejudice or disclaimer.

Each of claims 1, 12, 23, 34, and 45 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-44 are now pending in this application. Claims 45-56 have been withdrawn. Each of claims 1, 12, 23, and 34 are in independent form.

A. The Indefiniteness Rejections

Each of claims 2, 13, 24, and 35 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The present Office Action states that "the phrase 'less than about' renders the claim indefinite because the metes and bounds are unclear. It is suggested that Applicant amend 'less than about' to 'around'". These rejections are respectfully traversed.

Each of claims 2, 13, 24, and 35 has been cancelled without prejudice or disclaimer. Therefore, Applicant respectfully submits that each rejection thereof is moot.

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Each of claims 1-44 was rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of U.S. Patent No. 6,954,800 ("Mallory") and/or U.S. Patent No. 5,572,678 ("Homma"). These rejections are respectfully traversed.

I. Legal Standards**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach... all the claim limitations." See MPEP § 2143.

Moreover, the "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id.*

It is legal error to utilize to "substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." See *In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

"Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, 'the burden of coming forward with evidence or argument shifts to the applicant.'" *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

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"To establish *prima facie* obviousness..., '[a]ll words in a claim must be considered....'" MPEP 2143.03, quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); see also *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 166 USPQ 545, 548 (CCPA 1970); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789, 791 (CCPA 1974).

3. Motivation or Suggestion to Combine the Applied References

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." MPEP 2142. The requirements for fulfilling this burden are explicit and straightforward.

"[T]he examiner **must show reasons** that the skilled artisan, **confronted with the same problems** as the inventor and with no knowledge of the claimed invention, **would select the elements** from the cited prior art references for combination **in the manner claimed**." (emphasis added). *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998). To show these reasons, "[p]articular findings must be made". *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Such factual findings must be supported by "concrete evidence in the record". *In re Zurko*, 258 F.3d 1379, 1385-86, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Moreover, a showing of combinability must be "clear and particular". *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 161 (Fed. Cir. 1999). That strong showing is needed because, "**obviousness requires proof** 'that the skilled artisan . . . would select the elements from the cited prior art references for combination in the manner claimed'". *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006) (quotation omitted) (emphasis added).

Consequently, an Office Action must clearly and objectively prove that the applied references are "reasonably pertinent to the **particular** problem with which the invention was involved". See *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664, 57 USPQ2d 1161, 1166 (Fed. Cir. 2000); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir.

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1983); and *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881-83, 886, 45 USPQ2d 1977, 1981-82, 1985 (Fed. Cir. 1998).

In addition, "[t]he patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness." *In re Sang-Su Lee*, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Thus, the Office Action must clearly and objectively prove some "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; and

"combine [those teachings] in the way that would produce the claimed invention".

In re Johnston, 435 F.3d 1381 (Fed. Cir. 2006) (internal citations omitted). See also *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (discussing the "the test of whether it would have been obvious to select **specific** teachings and combine them as did the applicant") (emphasis added); and *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) ("When prior art references require selective combination... to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself."). "The absence of . . . a suggestion to combine is dispositive in an obviousness determination." *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997).

Further, this obviousness standard applies regardless of whether the Office Action relies upon modifying or combining purported teachings.

Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious modification of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the **desirability** of the modification . . . It is impermissible to use the claimed invention as an instruction manual or template to

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piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-1784 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); and *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) (internal quotations omitted) (emphasis added)).

Therefore, the Office Action also must clearly and objectively prove that the “prior art suggested the **desirability**” of that modification or combination. See also *Akamai Techs. v. Cable & Wireless Internet Servs.*, 344 F.3d 1186, 68 USPQ 2d 1186 (Fed. Cir. 2003) (“[w]hen determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the combination.”) (emphasis added).

II. Analysis

1. Claims 1-11

Independent claim 1, upon which each of claims 2-11 depend, recites, *inter alia*, yet the applied portions of Mallory fail to teach, “an Inter-Frame Gap (IFG) having a duration of **less than 17 μ sec**”. Instead, Mallory allegedly recites, at col. 23, lines 54-57, “the Inter-frame Gap **is 29.0 microseconds** (CS_IFG), where the gap is defined at the points at which the previous frame drops below 50% of its peak and the current frame rises above 50% of its peak.”

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach every

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limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested. Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Accordingly, Applicant respectfully requests a withdrawal of each rejection of claims 1-11.

Moreover, the present Office Action provides a legally insufficient motivation or suggestion to combine applied elements of Mallory with applied elements of Homma. Instead, the Office Action asserts, at page 4 regarding the claimed subject matter of claim 1, that

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mallory in view of Homma in order to enable frames using timing that is different than that defined by the HPNA vs2 specification. One would be motivated to do so in order to enable transferring a large amount of data among a plurality of computer-equipped stations on a network with high efficiency and high reliability.

Applicant respectfully asks where this bald, conclusory assertion provides evidence of some "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references"?

"select the teachings of [the] separate references"?

"combine [those teachings] in the way that would produce the claimed invention"?

Applicant further asks: where does the prior art suggest a desirability of the modification?

Applicant respectfully submits that no such evidence of a suggestion or motivation to combine references is presented regarding the claimed subject matter of any claim of the present Application. Accordingly, the present Office Action fails to establish a *prima facie* case of obviousness regarding any of claims 1-11. Accordingly, Applicant respectfully requests a withdrawal of each rejection of claims 1-11.

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2. Claims 12-22

The present Office Action fails to examine the specific claim language of each of claims 12-22.

Specifically, claim 12, upon which each of claims 13-22 depend, recites, *inter alia*, yet the present Office Action fails to allege that any applied portion of any relied upon reference teaches, "each HPNA v2 frame being timed to allow a plurality of physical layer priority level slots".

Moreover, claim 12 recites, *inter alia*, yet the present Office Action fails to allege that any applied portion of any relied upon reference teaches, **"the transmitted message being transmitted with a highest physical layer priority level available in an HPNA v2 frame"**. Accordingly, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 12 since "all words of a claim must be considered".

In addition, claim 1 recites, *inter alia*, yet the applied portions of Mallory fail to teach, "an Inter-Frame Gap (IFG) having a duration of less than 17 μ sec". Instead, Mallory allegedly recites, at col. 23, lines 54-57, "the Inter-frame Gap is 29.0 microseconds (CS_IFG), where the gap is defined at the points at which the previous frame drops below 50% of its peak and the current frame rises above 50% of its peak."

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested. Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Accordingly, Applicant respectfully requests a withdrawal of each rejection of claims 12-22.

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Moreover, the present Office Action provides no motivation or suggestion to combine applied elements of Mallory with applied elements of Homma regarding the claimed subject matter of claim 12.

Accordingly, the present Office Action fails to establish a *prima facie* case of obviousness regarding any of claims 12-22. Accordingly, Applicant respectfully requests a withdrawal of each rejection of claims 12-22.

3. Claims 23-33

The present Office Action fails to examine the specific claim language of each of claims 23-33.

Specifically, claim 23, upon which each of claims 23-33 depend, recites, *inter alia*, yet the present Office Action fails to allege that any applied portion of any relied upon reference teaches, "a communications signal in the communications medium having a sequence of blocking frames, each blocking frame having timing to allow an Inter-Frame Gap (IFG) having a duration of less than 17 μ sec, said IFG not recognized by an HPNA v2 station (STA) as a duration defined by an HPNA v2 specification for an HPNA IFG".

Moreover, claim 12 recites, *inter alia*, yet the present Office Action fails to allege that any applied portion of any relied upon reference teaches, "a Media Control Station (MC STA) transmitting a message to at least one selected non-Media Control Station (non-MC STA) during the blocking frames, and receiving a reply message in response to the transmitted message from the non-MC STA during the blocking frames". Accordingly, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 23 since "all words of a claim must be considered".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach every

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limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested. Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Accordingly, Applicant respectfully requests a withdrawal of each rejection of claims 23-33.

Moreover, the present Office Action provides no motivation or suggestion to combine applied elements of Mallory with applied elements of Homma regarding the claimed subject matter of claim 23.

Accordingly, the present Office Action fails to establish a *prima facie* case of obviousness regarding any of claims 23-33. Accordingly, Applicant respectfully requests a withdrawal of each rejection of claims 23-33.

4. Claims 34-44

The present Office Action fails to examine the specific claim language of each of claims 34-44.

Specifically, claim 34, upon which each of claims 35-44 depend, recites, *inter alia*, yet the present Office Action fails to allege that any applied portion of any relied upon reference teaches, "each HPNA v2 frame being timed to allow a plurality of physical layer priority level slots".

In addition, claim 34 recites, *inter alia*, yet the present Office Action fails to allege that any applied portion of any relied upon reference teaches, "a communications signal in the communications medium having a sequence of blocking frames, each blocking frame having timing to allow an Inter-Frame Gap (IFG) having a duration of less than 17 μ sec, said IFG not recognized by an HPNA v2 station (STA) as a duration defined by an HPNA v2 specification for an HPNA IFG".

Moreover, claim 34 recites, *inter alia*, yet the present Office Action fails to allege that any applied portion of any relied upon reference teaches, "a Media Control Station (MC STA) transmitting a message to at least one selected non-Media Control Station (non-MC STA), the

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transmitted message being transmitted with a highest physical layer priority level available in each HPNA v2 frame and during the blocking frames, the MC STA receiving a reply message in response to the transmitted message from the non-MC STA during the blocking frames". Accordingly, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 34 since "all words of a claim must be considered".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested. Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Accordingly, Applicant respectfully requests a withdrawal of each rejection of claims 34-44.

Moreover, the present Office Action provides no motivation or suggestion to combine applied elements of Mallory with applied elements of Homma regarding the claimed subject matter of claim 34.

Accordingly, the present Office Action fails to establish a *prima facie* case of obviousness regarding any of claims 34-44. Accordingly, Applicant respectfully requests a withdrawal of each rejection of claims 34-44.

5. Obviousness Summary

Thus:

- 1) There is no motivation or suggestion to combine the applied portions of Mallory with the applied portions of Homma to arrive at the claimed subject matter; and
- 2) Even if combinable or modifiable, the applied portions of references relied upon

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in the Office Action do not expressly or inherently teach every limitation of the claims.

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

It is respectfully noted that because the Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a "new grounds of rejection." Consequently, any Office Action containing such rejection can not properly be made final. See *In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining "new ground of rejection" and requiring that "when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference"), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO "has the initial duty of supplying the factual basis for its rejection").

C. Allowable Subject Matter

A potential statement of reasons for the indication of allowable subject matter is:
"none of the reference of record, alone or in combination, teaches the combination of limitations found in the independent claims. Namely, claims 1-44 are allowable because none of the references of record, alone or in combination, teaches, 'each blocking frame having timing to allow an Inter-Frame Gap (IFG) having a duration of less than 17 μ sec'".

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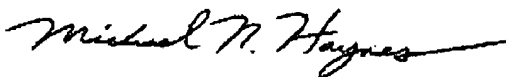
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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